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Paper No. 13

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**JAN 27 2003**

**OFFICE OF PETITIONS**

**ON PETITION**

In re Application of :  
McGraw et al. :  
Application No. 09/556,389 :  
Filed: April 24, 2000 :  
Attorney Docket No. 000309.00011 :

This is a decision on the renewed petition under 37 CFR 1.181, filed December 2, 2002, requesting refund of a filing fee, a notice of appeal fee, and extension of time fees.

The petition is **DISMISSED**.

Analysis:

35 USC 41(a) states, "The Director shall charge the following fees:"

35 USC 41(a)(1)(A) states, "On filing each application for an original patent, except in design or plant cases, \$690."

35 USC 41(a)(6)(A) states, "On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$300."

35 USC 41(a)(8) states, "For petitions for 1-month extensions of time to take actions required by the Director in an application-

- (A) on filing a first petition, \$110;
- (B) on filing a second petition, \$270; and
- (C) on filing a third or subsequent petition, \$490."

The use of the word "shall" in 35 USC 41 requires the Office to charge the fees.<sup>1</sup> Once the fees have been "charge[d]," the Office does not have the authority to refund the fee except under 35 USC 42 which permits refund of "any fee paid by mistake or any amount paid in excess of that required."

Petitioner cites Ex Parte Grady, 59 U.S.P.Q. 276 for the proposition that the criteria for refund of fees includes, "neglect or misinformation on the part of the office." The words quoted by petitioner are from a federal regulation which no longer exists. Refunds are currently provided for by 37 CFR 1.26 which does not include the quoted language.

<sup>1</sup> It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). The court in Boyden v. Comm'r of Patents, 441 F.2d 1041, fn 3, (D.C. Cir. 1971) states, "'Shall' is the language of command, Escoe v. Zerbst, 295 U.S. 490, 493, 55 S. Ct. 818, 79 L. Ed. 1566 (1935) as Mr. Justice Cardozo observed for a unanimous court. And see the discussion by Mr. Justice Stone in Richbourg Motor Co. v. United States, 281 U.S. 528, 534, 50 S. Ct. 385, 74 L. Ed. 1016 (1930)."

Petitioner has failed to supply a showing in compliance with 35 USC 42 which permits refund of "any fee paid by mistake or any amount paid in excess of that required." Petitioner had two choices prior to payment of the fees at issue:


- (1) not pay the fees and risk abandonment,
- (2) pay the fees and therefore eliminate the risk of abandonment.

Petitioner chose option (2). The fee was not paid by mistake. Instead, petitioner intentionally chose to pay the fee. In return, petitioner was able to eliminate the risk of abandonment.

Since petitioner has not provided a showing in compliance with 35 USC 42, the Office does not have the statutory authority to refund the fees.

The file is now being forwarded to Technology Center 3700.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

  
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